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| 10/030,741      | 11/30/2001  | Mary M. Dyszlewski   | 1328 WO/US          | 2094             |

7590 11/30/2004  
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EXAMINER

JONES, DAMERON L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1616

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/030,741

Applicant(s)

DYSZLEWSKI ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6,7,10, 11,13-16,23-26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,7,10,11,13-16,23-26 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 9/7/04 wherein claims 1-5, 8, 9, 12, 17-22, 27, and 29 were canceled and claims 6 and 15 were amended.

**Note:** Claims 6, 7, 10, 11, 13-16, 23-26, and 28 are pending.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

2. The Applicant's arguments filed 9/7/04 to the rejection of claims 6, 7, 10-16, 23-26, 28, and 29 made by the Examiner under 35 USC 103, 112, and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

### **Double Patenting Rejections**

The rejection of claims 6, 7, 10, 11, 13-16, 23-26, and 28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 9, 11, and 13-17 of US Patent No. 6,359,119 is MAINTAINED for reasons of record in the office action mailed 6/15/04.

**Note:** It is duly noted that Applicant intends to file a terminal disclaimer when the claims are indicated as patentable.

### **112 Rejections**

The 112, first and second, paragraph rejections are WITHDRAWN for reasons of record in Applicant's response.

### **103 Rejections**

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The 103 rejection over Pipes et al is WITHDRAWN for reasons of record in Applicant's response.

### **CLARIFICATION OF THE RECORD**

3. In the office action mailed 11/21/03, pages 2-4 (see the 102 and 103 sections), the rejections were maintained over (Alberto et al, J. Am. Chem. Soc., 1998, Vol. 120, pp. 7987-7988) because the prior art discloses imino-N,N-diacetic acid (IDA). Thus, while Applicant has amended the claims to overcome the 112, first and second, paragraph, rejections, the incorporation of IDA into the claims requires that the 102 and 103 rejections be re-instated for reasons of record (**Note:** in addition, the amended claims now overlap subject matter present in US Patent No. 6,344,178). Furthermore, it is noted that in Applicant's response filed 2/18/04, page 5, paragraph 4, it is stated that the claims were amended to encompass ligands having at least three carboxylate groups so that IDA would be excluded and the prior art overcome. However, the claims as now amended are not consistent with changes made to overcome the prior art.

### **NEW GROUNDS OF REJECTION**

#### **102 Rejections**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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5. Claims 6, 7, 10, 11, and 13-16 are rejected under 35 USC 102(a) as being anticipated by Alberto et al (J. Am. Chem. Soc., 1998, Vol. 120, pp. 7987-7988) is MAINTAINED for reasons of record in the office action mailed 2/5/03.

Applicant is respectfully requested to review the discussions regarding the cited prior art which are already of record.

### **103 Rejections**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 23, 24, 26, and 28 are rejected under 35 USC 103(a) as being unpatentable over Alberto et al (J. Am. Chem. Soc., 1998, Vol. 120, pp. 7987-7988) for reasons of record in the office action mailed 2/5/03.

Applicant is respectfully requested to review the discussions regarding the cited prior art which are already of record.

### **Double Patenting Rejections**

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 6, 7, 10, 11, and 14 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 3, and 12 of U.S. Patent No. 6,344,178. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a method of preparing a compound of general formula II. The claims differ in that those of the patented invention discloses that multiple compounds (including that of the instant invention) may be prepared from Applicant's general formula I and a ligand while the instant invention is directed to only one of the formulae disclosed in the patent. Therefore, it would be obvious to a skilled practitioner in the art that the inventions overlap.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'D. L. Jones', is positioned above the printed name.

D. L. Jones  
Primary Examiner  
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November 24, 2004